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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/049,652 09/23/92 SIMONS

M M-1647-6C-US

EXAMINER

TRAN, P

18N1/1213

LAURA TERLIZZI
SKJERVEN, MORRILL, MACPHERSON,
FRANKLIN & FRIEL
25 METRO DRIVE, SUITE 700
SAN JOSE, CA 95110

ART UNIT PAPER NUMBER

1807

DATE MAILED:

12/13/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 9/28/93 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 9 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 2. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. <u>7 pages</u> | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 3. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-43 are pending in the application.
Of the above, claims 28-34 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☒ Claims 1-16, 21-27, 37, 39-43 are allowed.
4. ☒ Claims 17-20, 35, 36, 38 are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-43 have been not subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable, ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner, ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved, ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received, ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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Part III DETAILED ACTION

1. Receipt of Applicant's Amendment filed September 28, 1993 (Paper No. 8) is acknowledged.

2. Applicant's election with traverse of Group I in Paper No. 8 is acknowledged. The traversal is on the ground(s) that examining both groups, which requires searching for at least 4 subclasses, places no serious burden on the Examiner. This is not found persuasive because searching for both groups would place a serious burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

3. The objections made in paragraphs 16 and 17 in the Office Action mailed March 25, 1993 (Paper No. 6) have been overcome by Applicant's amendment.

The rejections of Claim 27 made in paragraph 20; Claims 1-6 made in paragraph 21; Claims 37-43 in paragraph 23; Claims 42 and 43 in paragraph 25; Claims 1-16 and 37-41 in paragraph 26; and Claims 17-20 in paragraph 27 have been overcome by Applicant's amendment and traversal.

4. Regarding the withdrawal of the rejection of Claims 1-16 and 37-41 made in paragraph 26, both of the Declarations made by Gresshoff, filed September 23, 1992 (Paper No. 2), and Dr. Hood, filed September 28, 1993 (Paper No. 9), have been fully considered by the Examiner who finds them deemed persuasive to overcome the original basis of the rejection.

5. The rejection of Claims 35 and 36 made in paragraph 22 are being maintained. Applicant's traversal has been fully considered by the Examiner but it is not deemed persuasive. The Examiner agrees with Applicant that the claims encompass HLA. However Applicant discloses no other loci having at least 4 or 8 alleles as does HLA.

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6. The rejection of Claim 38 made in paragraph 24 is being maintained. At issue is not the definition of 1 kilobase, as Applicant addressed in responding to the rejection, but the claiming of "not more than about one kilobase in length". This language, as pointed out for the rejection, is not supported by the original specification, which discloses "between about 1000 to about 2000 nt in length" (emphasis added). This is the reason for the rejection based on new matter.

7. The rejection of Claims 17-20 made in paragraph 29 is being maintained. Applicant's traversal has been fully considered but it is not deemed persuasive. The traversal is based on that there is no motivation to combine Erlich and Saiki. The Examiner disagrees with Applicant for a motivation to combine was provided to support the rejection (see last paragraph in paragraph 29 of Paper No. 6). The Examiner wishes to point out to Applicant that the limitations that Applicant traverses for in the Remarks are not recited in the claims, which are drawn to methods to produce RFLP fragments: no limitations on the size of amplicons, the number of restriction sites, various combination of restriction site over tens of kilobases that produces the characteristic patterns.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED

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FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

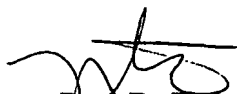
10. Any inquiry concerning this communication or those earlier from the examiner should be directed to Paul B. Tran, Ph.D. whose telephone number is (703) 308-4040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose phone number is (703) 308-0196.

Paper related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 305-3014.



MARGARET PARR
SUPERVISORY PATENT EXAMINER
GROUP 1800



Paul B. Tran, Ph.D.
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12/10/93